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08/926,882	09/10/1997	SHIGEO YAMAGATA	B208-062-DIV	7670
26272	7590	04/09/2003	EXAMINER	
ROBIN BLECKER & DALEY 2ND FLOOR 330 MADISON AVENUE NEW YORK, NY 10017			TRAN, THAI Q	
ART UNIT		PAPER NUMBER		
2615		33		
DATE MAILED: 04/09/2003				

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	08/926,882	YAMAGATA ET AL. <i>SD</i>
Examiner	Art Unit	
Thai Tran	2615	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1) Responsive to communication(s) filed on 27 January 2003.

2a) This action is **FINAL**.      2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4) Claim(s) 38-44 and 49-55 is/are pending in the application.

4a) Of the above claim(s) 38-44 is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 49-55 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some \* c) None of:

1. Certified copies of the priority documents have been received.

2. Certified copies of the priority documents have been received in Application No. 08/271,230.

3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) The translation of the foreign language provisional application has been received.

15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

1) Notice of References Cited (PTO-892)      4) Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)      5) Notice of Informal Patent Application (PTO-152)

3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_      6) Other: \_\_\_\_\_

## DETAILED ACTION

### ***Response to Arguments***

1. Applicant's arguments filed Jan. 27, 2003 have been fully considered but they are not persuasive.

In re pages 1-4, applicants argue that applicants' claims patentably distinguish over the cited art f record because it is quite clear from col. 5, lines 16-63 of the Shimada et al patent that nothing is stated in these lines as to the display on a display screen of the character data for the different recording modes "01" and "11", the fact that DATA 1 is recorded in mode "01" and DATA 1 and DATA 2 are recorded in mode "11" in the Shimada et al patent appears to have no bearing on the nature of the displays of the video character data and whether they are the same or different, it, furthermore, clearly has no bearing on the positions of the displays of the video character data on a display screen, the Examiner's conclusion that "the display positions of DATA 1 in tow mode should be different because the amount of data of two modes are different" is thus not believed to be correct or based on anything taught or suggested in the Shimada et al patent, and, similarly, the Examiner's argument that "the position of the character information to be displayed in both modes should be different because the amount of data of tow modes are different and the character information to be displayed is not changed" is likewise not believed to be correct or based on anything taught or suggested in the Shimada et al patent.

In response, the examiner respectfully disagrees. As discussed in paragraph #2 of the last Office Action, Shimada et al discloses in col. 4, lines 1-12 that DATA 1 is

recorded in mode "01" and DATA 1 and DATA 2 are recorded in mode "11". The amount of DATA1 in mode "01" and DATA 1 and DATA 2 in modes "11" are different. The examiner believes that the position at which the data of the first type (DATA 1 in mode "01") is superimposed on a display screen in the first mode and the position at which the data of the first type (DATA 1 and DATA 2 in mode "11") is superimposed on a display screen in the second mode are different from each other because the amount of data (DATA 1 in mode "01" and DATA 1 and DATA 2 in mode "11") in two modes (mode "01" and mode "11") are different.

### ***Double Patenting***

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 49-55 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-2 of U.S. Patent No. 5,719,984 in view of Shimada et al ('772) as set forth in paragraph #4 of the last Office Action.

Regarding claim 49 of this application, claim 1 of U.S. Patent No. 5,719,984 cites

all the claimed limitations except for providing means for superimposing the image information read out from the recording medium with the ID information read out from the recording medium; wherein said superimposing means has a first mode in which data of a first type contained in the ID data is superimposed with the image information, and a second mode in which the data of the first type and data of a second type contained in the ID data are both superimposed with the image information; and wherein the position at which the data of the first type is superimposed on a display screen in said first mode and the position at with the data of the first type is superimposed on a display screen in the second mode different from each other.

Shimada et al teaches an apparatus for recording additional video signal having means (col. 4, lines 1-21 and col. 5, lines 16-63) for superimposing the image information read out from the recording medium with the ID information read out from the recording medium; wherein said superimposing means has a first mode in which data of a first type contained in the ID data is superimposed with the image information, and a second mode in which the data of the first type and data of a second type contained in the ID data are both superimposed with the image information (col. 4, lines 1-21 and col. 5, lines 16-63); and wherein the position at which the data of the first type is superimposed on a display screen in said first mode and the position at with the data of the first type is superimposed on a display screen in the second mode different from each other (col. 4, lines 1-21 and col. 5, lines 16-63) so that the superimposing characters and so forth in a recording mode can be simplified (col. 1, lines 42-52).

It would have been obvious to one of ordinary skill in the art at the time of the

invention to provide claim 1 of U.S. Patent No. 5,719,984 with the capability of superimposing characters on the video signal reproduced from the recording medium as taught by Shimada et al in order to simplify superimposing characters on the video signal in recording and reproducing modes.

Regarding claim 50 of this application, claim 2 of U.S. Patent No. 5,719,984 cites wherein the data of the first type is date information.

Regarding claim 51 of this application, claim 1 of U.S. Patent No. 5,719,984 cites all the claimed limitations except for providing reading means for reading the information signal and ID information of the information signal from the recording medium; conversion for converting the ID information read out from the reading means into a character information; setting means for setting a display mode of the character information converted by the conversion means on the display device; superimposing means for superimposing the information signal with the character information converted by the conversion means to output the information signal superimposed with the character information to the display device; control means for changing a superimposing position on a display screen of the character information superimposed by the superimposing means according to a display mode set by the setting means; and wherein the control means vary, depending on the display mode, the position at which the character information is displayed, even when the character information is not changed.

Shimada et al teaches an apparatus for recording additional video signal having reading means (1 and 8 of Fig. 1, col. 5, lines 16-26) for reading the information signal

and ID information of the information signal from the recording medium; conversion means (14 of Fig. 1, col. 4, lines 34-40) for converting the ID information read out from the reading means into a character information; setting means (15 of Fig. 1, col. 5, lines 29-45) for setting a display mode of the character information converted by the conversion means on the display device; superimposing means (20 of Fig. 1, col. 5, lines 48-63) for superimposing the information signal with the character information converted by the conversion means to output the information signal superimposed with the character information to the display device; control means (15 and 18 of Fig. 1, col. 5, lines 29-63) for changing a superimposing position on a display screen of the character information superimposed by the superimposing means according to a display mode set by the setting means; and wherein the control means vary, depending on the display mode, the position at which the character information is displayed, even when the character information is not changed (col. 5, lines 16-63) so that the superimposing characters and so forth in a recording mode can be simplified (col. 1, lines 42-52).

It would have been obvious to one of ordinary skill in the art at the time of the invention to provide claim 1 of U.S. Patent No. 5,719,984 with the capability of superimposing characters on the video signal reproduced from the recording medium as taught by Shimada et al in order to simplify superimposing characters on the video signal in recording and reproducing modes.

Regarding claim 52, Shimada et al also discloses the claimed wherein the claimed setting means sets the display mode according to a number of items contained in the ID information (col. 4, lines 1-21 and col. 5, lines 29-63).

Regarding claim 53, the combination of claim 1 of U.S. Patent No. 5,719,984 and Shimada et al discloses all the features of the instant invention except for providing that the information signal recording in the recording medium is an image taken by an electronic camera and the ID information includes a date of image-taking.

The capability of using the electronic camera to recording an image and the date of image-taking is old and well known in the art and therefore Official Notice is taken.

It would have been obvious to one of ordinary skill in the art at the tie of the invention to incorporate the well known electronic camera into claim 1 of U.S. Patent No. 5,719,984 in order to record the desired image.

The method claim 54 is rejected for the same reasons as discussed in the apparatus claim 49 above.

The method claim 55 is rejected for the same reasons as discussed in the apparatus claim 51 above.

#### ***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 49, 51-52 and 54-55 are rejected under 35 U.S.C. 102(b) as being anticipated by Shimada et al ('772) as set forth in paragraph #6 of the last Office Action.

Regarding claim 49, Shimada et al discloses a reproducing apparatus (Fig. 1) for reading out image information and ID data of the image information from a recording

medium recorded with the image information and the ID data of the image information to output the information and the ID data thereof to a display device having means (1 and 8 of Fig. 1, col. 5, lines 16-26) for reading out the image information; means (20 of Fig. 1, col. 5, lines 48-63) for superimposing the image information read out from the recording medium with the ID information read out from the recording medium; and output means (28 of Fig. 1, col. 5, lines 48-54) for outputting the image information and the ID information superimposed by the superimposing means to the display device; wherein said superimposing means has a first mode in which data of a first type contained in the ID data is superimposed with the image information, and a second mode in which the data of the first type and data of a second type contained in the ID data are both superimposed with the image information (col. 4, lines 1-21 and col. 5, lines 16-63); and wherein the position at which the data of the first type is superimposed on a display screen in said first mode and the position at with the data of the first type is superimposed on a display screen in the second mode different from each other (col. 4, lines 1-21 and col. 5, lines 16-63).

Regarding claim 51, Shimada discloses a reproducing apparatus (Fig. 1) for reading out information signal from a recording medium to output the signal to a display device having reading means (1 and 8 of Fig. 1, col. 5, lines 16-26) for reading the information signal and ID information of the information signal from the recording medium; conversion means (14 of Fig. 1, col. 4, lines 34-40) for converting the ID information read out from the reading means into a character information; setting means (15 of Fig. 1, col. 5, lines 29-45) for setting a display mode of the character information

converted by the conversion means on the display device; superimposing means (20 of Fig. 1, col. 5, lines 48-63) for superimposing the information signal with the character information converted by the conversion means to output the information signal superimposed with the character information to the display device; control means (15 and 18 of Fig. 1, col. 5, lines 29-63) for changing a superimposing position on a display screen of the character information superimposed by the superimposing means according to a display mode set by the setting means; and wherein the control means vary, depending on the display mode, the position at which the character information is displayed, even when the character information is not changed (col. 5, lines 16-63).

Regarding claim 52, Shimada et al also discloses the claimed wherein the setting means sets the display mode according to a number of items contained in the ID information (col. 4, lines 1-21 and col. 5, lines 29-63).

The method claim 54 is rejected for the same reasons as discussed in the apparatus claim 49 above.

The method claim 55 is rejected for the same reasons as discussed in the apparatus claim 51 above.

#### ***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

7. Claims 50 and 53 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shimada et al ('772) as set forth in paragraph #8 of the last Office Action.

Regarding claim 50, Shimada et al discloses all the features of the instant invention (see the rejection of claim 49 above) except for providing that the common item is a date information.

Shimada et al teaches in col. 6, lines 3-9 that "according to the present invention, as described hereinabove, it becomes possible to additionally insert any of titles, subtitles, superimposed time indications, superimposed commercials, superimposed dialogues and still pictures by the technique of after-recording in a track region Sp formed for coded audio signal".

It would have been obvious to one of ordinary skill in the art at the time of the invention to record the date information in a track region Sp formed for coded audio signal since it merely amounts to selecting characters information.

Regarding claim 53, Shimada et al discloses all the features of the instant

Invention (see the rejection of claim 51 above) except for providing that the information signal recording in the recording medium is an image taken by an electronic camera and the ID information includes a date of image-taking.

The capability of using the electronic camera to recording an image and the date of image-taking is old and well known in the art and therefore Official Notice is taken.

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the well-known electronic camera into Shimada et al's system in order to record the desired image.

**8. THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

**9.** Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thai Tran whose telephone number is (703) 305-4725. The examiner can normally be reached on Mon. to Friday, 8:00 AM to 5:30 PM.

The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9314 for regular communications and (703) 872-9314 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Technology Center 2600 Customer Service Office whose telephone number is (703) 306-0377.

TTQ  
April 5, 2003



THUY TRAN  
PRIMARY EXAMINER